

REMARKS

This Amendment is made to the Office Action dated May 4, 2004. Claims 1, 3, 4, 6-11, and 13-35 were pending in this application. New claims 36 and 37 are being presented for consideration. Reconsideration of the rejected claims is respectfully requested.

Applicant notes that the Examiner has indicated that claim 34 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicant thanks the Examiner for indicating that claim 34 would be allowable; however, Applicant has not rewritten the claim in independent form in view the remarks which pertain to claims 32 and 33 below.

Applicant again strongly disagrees with the Examiner's treatment of the prior art cited against the rejected claims. In rejecting the pending claims, the Examiner has selectively colored stent patterns appearing in the cited art to achieve a desired structural element while completely disregarding the unambiguous disclosure of the prior art which clearly and specifically identifies the elements of the stent pattern disclosed in the cited prior art. As a result, the Examiner has simply used the pending claims as a roadmap to recreate and find the claimed stent pattern in the prior art. The Examiner claims that the pending claims read on the cited references, however; the Examiner does so by completely disregarding the teachings and disclosure of the cited references.

For example, one of the references (the Dang patent) states that an element is a W-shaped element. One skilled in the art, or anyone by that matter, would read the Dang patent and recognize the structure as being a W-shaped element. However, the Examiner reads the Dang patent and says that this element clearly marked as a W-shaped element is not W-shaped, but rather, is a V-shaped element, while at the same time taking the position that the exact same stent structure appearing next to this alleged V-shaped element is W- shaped. This simply is not a case of the Examiner and the references using different words to describe the same structure, but rather, the Examiner's attempt to completely redefine and change the disclosed structure in order to meet the claim

language of the rejected claims. The Examiner does the same with regard to the Allen application, as will be addressed in detail below. In each case, the Examiner redefines the structure, as may be needed, in direct contradiction to the unambiguous disclosure in each of these references.

The Examiner also has been inconsistent in identifying the same pattern disclosed in the cited references by characterizing the exact same pattern, either a W-shaped or V-shaped element, as needed, in an attempt to achieve Applicant's claimed pattern. This practice completely disregards the clear teachings of the prior art and supports Applicant's position that the Examiner has impermissibly relied on the pending claims as a road map, allowing the Examiner to selectively find elements as needed to achieve the claimed stent pattern.

The Examiner has rejected claims 1, 3, 6, 8, 9, 11, 17, 18 and 21-31 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,935,162 to Dang, et al. (the "Dang patent"). The Examiner has reproduced FIG. 6 from the Dang patent and has selectively colored portions of the strut pattern in order to recreate the particular element recited in Applicant's claimed stent pattern. In doing so, the Examiner has completely disregarded the disclosure of the Dang patent. While the Dang patent shows a plurality of W-shaped members appearing in the stent pattern of FIG. 6, the Dang patent does not show V-shaped peaks and valleys as suggested by the Examiner. In fact, the Dang patent does not even utilize the term V-shaped or U-shaped in connection with its description of the various shaped elements which make up each cylindrical section. For that reason, the Examiner's selective coloring of a W-shaped portion in FIG. 6 of the Dang patent totally disregards the teaching of the Dang patent in an attempt to reconstruct Applicant's invention. The V-shaped portion which the Examiner contends appears in the Dang patent are improperly created by using the pending claims as a road map, by selectively coloring W-shaped portions to appear as V-shaped portions, and by completely disregarding the clear disclosure of the Dang patent.

The various components disclosed in FIG. 6 of the Dang patent are clearly identified in the following passage from the Dang patent:

“The cylindrical sections 222 are preferably arranged such that the W-shaped elements 230 in adjacent cylindrical sections 220 alternate between pairs of W-shaped elements 230 that open towards each other and pairs of W-shaped elements 230 that open away from each other when moving around the perimeter or circumference of the stent 210 (i.e., transverse to the axis 214 or in the hoop direction). The pairs of W-shaped elements 230 that open towards each other from adjacent cylindrical sections 220 are connected by tie members 250 to form cells 240 in a manner similar to that described above with respect to stents 10 and 110.” (Column 7, lines 55-65.)

Therefore, the portion of the strut pattern which has been colored green by the Examiner is not a V-shaped peak portion or a V-shaped valley portion, but rather, as is clearly identified in the above passage, a W-shaped portion. Applicant thus believes that the Examiner’s selective coloring of portions of the stent pattern of FIG. 6 is an attempt to impermissibly reconstruct and redefine the structure disclosed in the Dang patent to achieve the claimed stent pattern.

The danger of creatively coloring portions of the Dang patent in order to achieve the claimed structure is now addressed. Referring specifically to page 3 of the Office Action, in the topmost cylindrical section, identified by the numeral 220a, the Examiner has colored the W-shaped peak portion at the far left in red and has indicated that it is a W-shaped peak portion. The exact structure (which is not colored in) appearing next to this W-shape peak portion has been characterized by the Examiner as a V-shaped peak portion. On this same cylindrical section 220a, at the right, the Examiner has colored in red a W-shaped valley portion and in green an alleged V-shaped valley portion. The Examiner’s selective coloring of this cylindrical section, however, fails to achieve the basic strut pattern called in all of the claims, namely, alternating peak and valley portions. Rather, the Examiner designation of elements in the Dang patent calls for valley portions to be connected to valley portions and peak portions to be connected to peak portions. Accordingly, the basic alternating pattern of peaks and valleys is lacking in the Dang patent. Applicant respectfully requests the Examiner to withdraw the §102(b) rejection based on the Dang patent as applied to the claims at issue.

The Examiner's inconsistency in improperly coloring the W-shaped elements appearing in the Dang patent is quite evident from the positions the Examiner has taken earlier in the prosecution of this case. In this Office Action, the Examiner has colored the W-shaped peak portion appearing in the topmost cylindrical section of 220a in red to indicate that it is a W-shaped peak portion. Immediately adjacent to this W-shaped portion is the same structure which the Examiner indicates is a V-shaped peak portion. However, reference is made to the Office Action of February 25, 2003, specifically to page 4, which shows this same Fig. 6 reproduced from the Dang patent but colored differently by the Examiner. In the Office Action of February 25, 2003, this same element which the Examiner now calls a V-shaped peak portion was identified as a W-shaped valley portion and colored in red by the Examiner. Thus, in two separate Office Actions, the Examiner has characterized the same element as a W-shaped portion or V-shaped portion, whatever is needed at the time to recreate the claimed stent pattern. These inconsistencies show that the Examiner has improperly interpreted the Dang patent and has simply selectively colored and characterized elements appearing in the Dang patent as is needed to support a rejection of the pending claims.

The Examiner has rejected claims 1, 3, 4, 6-11, 13-19 and 21-23 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. US 2001/0016770A1 to Allen et al. (the "Allen application"). In the Office Action, the Examiner has reproduced FIG. 8 from the Allen application and has selectively colored various shapes of the stent pattern in an attempt to reconstruct Applicant's invention. With regard to claims 1, 3-4, 6-7, 8-10, 17-19 and 21-22, the Examiner has colored in red V-shaped portions and portions of the stent pattern that the Examiner considers to be W-shaped peak portions. The Examiner has likewise colored in green V-shaped portions and portions of the stent pattern that the Examiner considers to be W-shaped valley portions. However, in selectively coloring the stent pattern, the Examiner has disregarded the disclosure of the Allen application that specifically identifies the various elements of the stent pattern which constitute a peak and valley portion.

Referring specifically to the disclosure relating to the embodiment shown in reproduced FIG. 8, the Allen application clearly defines alternating peak portions with the numeral 52 and valley portions with the numeral 54. The Allen application, at column 3 [0040] states as follows:

“In this embodiment, each peak portion 52 or valley portion 54 is reinforced by reinforcing member 44 extending across bend 56 to interconnect struts 58.”

Each reinforcing member 44 extends across connecting struts 58 which form each peak portion 52 or valley portion 54 of the embodiment of FIG. 8. The Examiner, in an attempt to duplicate Applicant's claimed invention, has merely traced portions of the cylindrical element 12 and portions of the reinforcing member 44 to create what appears to be a W-shape portion, claiming that it constitutes either a peak portion or valley portion. However, the reinforcing member 44 used in the Allen application clearly is shown and described as a connecting link which connects the struts that form either the peak portion or valley portion of the cylindrical element 12. Accordingly, the W-shape highlighted in red or green by the Examiner can not constitute a peak or valley portion of the cylindrical element since the uncolored portion attached to the colored W-shaped portion defines the respective peak or valley portion of the cylindrical element. At best, the portion of the stent pattern which the Examiner has colored and identified as a W-shaped pattern constitutes an intermediate strut which lies adjacent to a peak portion or valley portion of the cylindrical element. However, it is this uncolored portion which forms the peak or valley. Therefore, this portion of the cylindrical element, which the Examiner has carefully colored, cannot define a peak or valley since there is the presence of struts (the uncolored portion) which constitutes the peak or valley. Since the claims at issue require a W-shaped peak or valley portion, the portion colored by the Examiner simply cannot define a peak or valley. The presence of additional struts which, when read in context with the Allen application, constitute the peak or valley in that portion of the stent pattern simply cannot be ignored. Applicant respectfully requests the Examiner to withdraw the §102(e) rejection based on the Allen application.

It is noted that claims 1-22 include the recitation of a “substantially linear shaped” interconnecting member. The Examiner has identified a “connecting member” in the Allen application by the color yellow. However, the Examiner disregards the specification of the Allen application which identifies the interconnecting member by the numeral 50. The portion of the stent pattern which the Examiner has colored yellow is clearly identified as either a valley portion 54 or a reinforcing member 44 in the Allen application. Again, Applicant believes that the Examiner’s characterization of a portion of a valley portion or the reinforcing member as an interconnecting member simply ignores the disclosure of the Allen application. Moreover, it is not seen how this composite structure colored in yellow constitutes a “substantially linear shaped” interconnecting member. Accordingly, for this reason alone, the Examiner should withdraw the Allen application as an anticipatory reference at least as to claims 1-22.

The Examiner has rejected claim 20 under 35 U.S.C. § 103 as being anticipated by the Allen application”). Applicant respectfully submits that the Allen application and the present application were, at the time the presently claimed invention was made, each either owned by or subject to an obligation of assignment to Advanced Cardiovascular Systems, Inc. Applicant directs the Examiner’s attention to the recorded assignment of the present invention to Advanced Cardiovascular Systems, Inc., which is recorded at Reel/Frame 011411/0716 on December 28, 2000. The present application was filed after the November 22, 1999 effective date of change to 35 U.S.C. § 103(c) which disqualifies § 102(e) prior art from consideration under § 103 if the subject matter of the reference and the claimed invention were commonly owned at the time the claimed invention was made. The Allen application was cited as a § 102(e) reference and has been cited in the current Office Action as a § 103(a) reference. Applicant herein states that the Allen application and the present application were, at the time the invention was made, each either owned by or subject to an obligation of assignment to the same company. In view of this statement of common ownership, Applicant respectfully asserts that the Allen application is not a valid 35 U.S.C. § 103 (a) reference and traverse the current rejections. MPEP 706.02 (I) (2).